REMARKS/ARGUMENTS

Favorable reconsideration of this application, as presently amended and in light of the following discussion is respectfully requested.

Claims 2, 3, 5-20, 22-40 and 42-55 are pending in the case. No claim amendments are presented, thus, no new matter is added.

In the outstanding Official Action, Claims 2-20, 22-40, and 42-55 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting in view of copending Application 09/684,965 filed October 10, 2000 (hereinafter, "the '965 application") in view of Navarre et al. (U.S. Patent 6,442,611, hereinafter "Navarre"); and Claims 2, 3, 5-20, 22-40, and 42-55 were rejected under 35 U.S.C.103(a) as being unpatentable over Navarre in view of Miller et al. (U.S. Patent No. 5,475,819) and Chen et al. (U.S. Patent No. 6,009,442, hereinafter "Chen").

As the outstanding obviousness-type double patenting rejection is provisional in nature, Applicants respectfully request that this rejection be held in abeyance until the substantive merits of the presently pending case (as well as the '965 application) are addressed. At which time Applicants maintain the right to file a terminal disclaimer against the '965 application to obviate the outstanding obviousness-type double patenting rejection.

The Official Action has rejected Claims 2-20, 22-40 and 42-55 under 35 U.S.C. § 103 as unpatentable over Navarre in view of Miller. The Official Action cites Navarre as disclosing the Applicants' invention with the exception of selecting an application service provider (ASP). The Official Action cites Miller and Chen[1] as disclosing this limitation and states that it would have been obvious to one of ordinary skill in the art at the time the

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[1] The outstanding Official Action cites Chen in rejecting independent Claim 2, but only states only that Chen "teaches the document interface management." Thus, as it is unclear which feature of independent Claim 2 Chen is intended to address, Applicants consider that this reference is cited to address the "selecting an ASP" feature noted above.

invention was made to combine the reference teachings. Applicants respectfully traverse this rejection, as independent Claims 2, 22 and 40 state novel features clearly not taught or rendered obvious by the applied references.

Amended independent Claim 2 recites, *inter alia*, a method for managing ASP transactions between an ASP and an ASP user, comprising:

> ...determining whether a document profile exists for said user identifier received, ***said document profile indicating at least one available ASP configured to perform document management***;
> sending to said user a document manager interface screen based on said determination of whether a document profile exists, said document manager interface screen indicating the at least one available ASP indicated by the document profile;
> selecting an ASP for processing said transaction request from said document manager interface screen; and
> transmitting instructions for performing said transaction request, via said communications network, to said selected ASP.

Independent Claims 22 and 40, while directed to alternative statutory embodiments, recite substantially similar features as independent Claim 2. Accordingly, the arguments presented below are applicable to each of amended independent Claims 2, 22 and 40.

As summarized in the previous response, Navarre describes a method and gateway for gaining access to a plurality of local criminal record databases.[2] Navarre describes that a user submits user authentication information and search request information to a gateway (420), which formats and transmits the data to the database(s) (430-460) for processing.[3] The database(s) then return a response based on the received information, which is formatted by the gateway (420) to be displayed to the user at the client application.[4]

Navarre, however, fails to teach or suggest determining whether a document profile exists for a received user identifier, ***said document profile indicating at least one available***

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[2] Navarre at Fig. 3.
[3] Navarre at col. 2, lines 50-65.
[4] Id.

ASP configured to perform document management, as recited in amended independent Claim 2. Further, the outstanding Official Action fails to address this claim limitation, whatsoever.

In addressing the "determining whether a document profile exists for the user identifier feature," recited in independent Claim 2, the outstanding Official Action cites col. 4, lines 47-60 and Fig. 3 of Navarre. This cited portion of Navarre describes that once user authentication is complete, a user profile is used to create a menu of services accessible for the client for that session. Specifically, Navarre's menu indicates the various local law enforcement databases (e.g., Du Page County, Kane County, etc.) available for keyword searching by a user.

However, these local law enforcement databases simply store information related to individuals, and do not perform any *document management* services whatsoever, and, therefore, are not analogous to the ASP(s) recited in the claims. Thus, Navarre describes that a user profile exists, but fails to teach or suggest determining that a *document profile indicating at least one available ASP which is configured to perform document management exists for a received user identifier*, as recited in amended independent Claim 2.

Further, in addressing the "sending to said user a document manager interface screen based on said determination of whether a document profile exists" feature recited in independent Claim 2, the outstanding Official Action relies on col. 4, lines 58-60 of Navarre. However, as discussed above, Navarre fails to teach or suggest determining that a *document profile* exists, whatsoever, and therefore also fails to teach or suggest the sending, selecting and transmitting steps, all which discuss the use of the ASP based on a document profile indicating available ASPs, as recited in amended independent Claim 2.

As discussed above, Navarre fails to teach or suggest determining that a *document profile indicating at least one available ASP which is configured to perform document management* exists for a received user identifier. Likewise, neither Miller nor Chen, neither alone, nor in combination, remedy this deficiency.

Specifically, the portion of Miller cited in the outstanding Official Action describes configuration profiles related to service providers to resolve the issue of selecting one of several service providers when a request is made. Thus, the profile information of Miller is only associated with selecting an appropriate service provider and is in no way associated with a received user identifier, as claimed. Further, the configuration profile of Miller is used only after the selection of a service has been made, which is in contrast to the claimed configuration that uses the document profile to indicate services available for a user before service provider selection.

The outstanding Official Action cites col. 6, lines 12-55 of Chen in addressing independent Claim 2. As noted above, it is unclear for which feature of Claim 2 Chen is asserted, nonetheless, the cited portion of the reference describes an index and retrieval engine used to store and retrieve documents. However, the reference fails to teach or suggest any features related to the determining that a document profile exists for a user, whatsoever.
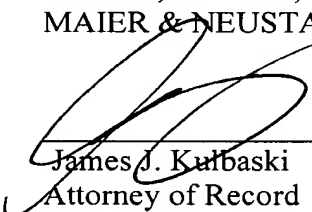
Therefore, none of the cited references, alone or in combination teach or suggest Applicants' Claims 2, 3, 5-20, 22-40, and 42-55 which include the feature of "determining that a *document profile indicating at least one available ASP which is configured to perform document management* exists for a received user identifier," by virtue of independent recitation or dependency. Therefore, the Official Action fails to provide a *prima facie* case of obviousness with regard to any of these claims.

Accordingly, Applicant respectfully requests the rejection of Claims 2, 3, 5-20, 22-40 and 42-55 under 35 U.S.C. § 103 in view of <u>Navarre</u>, <u>Miller</u> and/or <u>Chen</u> be withdrawn.

Consequently, in view of the present amendment and in light of the foregoing comments, it is respectfully submitted that the invention defined by Claims 2, 3, 5-20, 22-40 and 42-55 is patentably distinguishing over the applied references. The present application is therefore believed to be in condition for formal allowance pending the submission of a Terminal Disclaimer, and an early and favorable reconsideration of the application is therefore requested.

Respectfully submitted,

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